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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,728

09/08/2006

Harri Juntunen

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EXAMINER

O BRIEN, JEFFREY D

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

03/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,728	Applicant(s) JUNTUNEN, HARRI	
	Examiner Jeffrey O'Brien	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 5, 7-9, 11-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art as shown in Figs. 1-3, herein referred to as APA, in view of Silva et al. (US 5,027,919) herein referred to as '919.

4. For Claims 5, 9 and 13, APA discloses all the elements except for at the beveled end of the control part, a support part and a collar that is a resilient material and can be placed around the support part for providing a supporting surface that can be placed against the door closer body, which control part and collar are used for supporting the control device on the door closer body and holding the control device in place in the pressure medium flow, which support is based on compression of the collar.

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5. '919 teaches a valve having a beveled end (Fig. 1: 26) of a control part and at the beveled end of the control part, a support part (annotated Fig. 1: A) and a collar (B) that is a resilient material (wherein '919 is silent as to the material, but wherein bearings or collars are typically metal or plastic, both of which have some amount of resiliency) and can be placed around the support part (A) for providing a supporting surface that can be placed against the housing body. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the support part and collar of the valve of '919 to the valve of APA in order to allow for a close sliding relationship with the inner wall of the door closer body.

6. Examiner further notes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the collar of a resilient material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

7. Further, the Examiner notes that the phrase "which control part and collar are used for supporting the control device on the door closer body and holding the control device in place in the pressure medium flow, which support is based on compression of the collar", "for supporting said opposite end...", "whereby the control device can be moved...", "wherein the support of said opposite end...", in the claim is intended use language. **Applicant's claims are replete with intended use language**, and it has

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been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

8. It is further noted that '919 teaches that "appropriate seals may be furnished to prevent fluid contained within the inlet and exit regions from passing between the bearings and the inside wall of housing opening." '919 is silent as to the type or structure of the seal, however these seals could be formed integrally (as forming integrally what was formerly separate is old and well known, see MPEP 2144.04) with the bearings/collar elements. Therefore '919 teaches collar members which compress or are capable of compression.

9. For Claims 7 and 11, APA as modified by '919 discloses a device according to claims 5 and 9, wherein the collar is capable of being preinstalled in the door closer body so that when the control device is installed in the door closer, the support part of the control device becomes seated in the collar. Examiner notes that this would be considered to be a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. For Claims 8, 12 and 15, APA as modified by '919 discloses a device according to claims 5, 9 and 13, except wherein the collar is plastic. '919 is silent as to the material of the collar (B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the collar of a resilient material such as plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

11. Claims 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art as shown in Figs. 1-3, herein referred to as APA, in

view of Silva et al. (US 5,027,919) herein referred to as '919, as applied to Claim 5 above, and further in view of Hann (US 2,275,624) herein referred to as '624.

12. For Claims 6, 10 and 14, APA as modified by '919 discloses a device according to claims 5, 9 and 13, except wherein the collar comprises at least one chase to reduce its thickness at a certain part of the collar. '624 teaches a valve wherein a collar portion (Fig. 1: 6) comprises at least one chase (9) to reduce its thickness at a certain part of the collar. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the chase of '624 to the valve of APA as modified by '919 in order to control the flow of a fluid between chambers.

Response to Arguments

13. Applicant's arguments filed 1/12/2009 have been fully considered but they are not persuasive.

14. In response to applicant's argument that '919 would degrade or prevent the control function of APA, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

15. '919 teaches the use of an extended support and collar element that engage a bore in the housing, this structure serves to hold the valve in place in the housing while it moves axially. It would have been obvious to one of ordinary skill in the art to apply

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this to the axially moving valve of APA to support and hold the valve of APA in the housing.

16. Applicant's arguments with respect to "compression of the collar" are not persuasive. Examiner notes that this is functional language and that "collar of resilient material", which is structurally claimed could be any material such as metal or plastic that has some amount of resilience. It is further noted that '919 teaches that "appropriate seals may be furnished to prevent fluid contained within the inlet and exit regions from passing between the bearings and the inside wall of housing opening." '919 is silent as to the type or structure of the seal, however these seals could be formed integrally (as forming integrally what was formerly separate is old and well known, see MPEP 2144.04) with the bearings/collar elements. Therefore, '919 teaches collar members which compress or are capable of compression.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey O'Brien whose telephone number is (571)270-3655. The examiner can normally be reached on Monday through Friday 8:00am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor Batson/
Supervisory Patent Examiner, Art Unit 3677

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